

Remarks:

In response to Applicant's March 3, 2004 Office Action Response, the Examiner issued a Final Rejection, mailed April 16, 2004. Within the Final Rejection, the Examiner rejected Claims 1-2, 4-6, 8, 10-11, 13, 15-18, and 21 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,286,682 to Hansen in view of U.S. Patent No. 6,119,847 to Mooney et al. ("Mooney"). In light of the foregoing amendments to the claims and the following Remarks, the Applicant respectfully disagrees.

The Examiner further noted that independent Claim 1 was broadened by removing lines 11 and 12, in response to the Examiner's December 10, 2003 objection that the term "actuator" was not originally disclosed in the pending patent application. In light of the following Remarks, the Applicant respectfully requests that the Examiner, through an Examiner amendment, amend the drawings to show the actuator as originally claimed and added within the drawings submitted by Applicant on July 17, 2003. Additionally, the Applicant respectfully requests that the Examiner allow re-entry of the term "actuator" within the pending claims.

"Actuator" Objection:

First, the Applicant wishes to thank the Examiner for his participation in a May 7, 2004 telephone interview. During the interview, the Applicant inquired about the Examiner's December 10, 2003 objection to the term "actuator" within the claims.

As background, the Examiner first made an objection to the term "actuator" in a March 5, 2003 Office Action. In the Office Action, the Examiner noted that the term "actuator" was present in original Claim 2, but not shown in the drawings. Accordingly, in its July 17, 2003

reply, Applicant corrected the drawings to illustrate the actuator. The Examiner subsequently accepted the drawing amendment, noting in its August 14, 2003 Office Action that, “[c]onsidering that to one skilled in the art at the time of the invention would use a hydraulic actuator to assist in moving the second segment into storage/unloading position(s), the Examiner in view of the obviousness accepts the drawing change.”

However, in the next Office Action, dated December 10, 2003, the Examiner issued the same actuator objection, directing Applicant’s newly appointed outside counsel to delete the actuator element within the pending claims. Accordingly, despite the Examiner’s earlier acceptance of the amended drawings, outside counsel deleted the actuator element from Claims 1, 4, 6, and 11.

Thus, in light of the preceding background and the Examiner’s favorable statements in its May 11, 2004 Interview Summary (“Examiner will consider arguments and amendment favorably, in view of Applicant’s statement that utilizing an actuator to move the segments relative to each other (such as pivoting) would be well known to one skilled in the art”), Applicant respectfully requests re-entry of the term “actuator” within the pending Claims 1, 6, 11, 22, 25, and 28 and acceptance of the July 17, 2003 amended drawings.

103(a) Rejection of Claims 1-2, 4-6, 8, 10, 11, 13, 15-18, and 21:

On April 16, 2004, the Examiner gave a Final Rejection to Claims 1-2, 4-6, 8, 10-11, 13, 15-18, and 21, stating that Hansen discloses the claimed invention, except for the foldable unloading auger. The Examiner then concluded that Mooney discloses that it is known in the art to provide any number of foldable outfeed augers; thus, it would that have been obvious to one

having ordinary skill in the art at the time the invention was made to provide the single outfeed auger of Hansen with the foldable features taught by the outfeed auger taught by Mooney, since it is desirable to provide an auger type conveyor with foldable features to fold them into a relatively compact unit. The Applicant respectfully disagrees.

Again, the Applicant wishes to thank the Examiner for his participation in a May 7, 2004 telephone interview; the Applicant is extremely appreciative for the Examiner's time. During the interview, the Applicant and Examiner discussed the teachings of both Hansen and Mooney. More specifically, the Applicant discussed how both Hansen and Mooney teach away from the present invention. The Applicant further suggested potential claim amendments and indicated its desire to come to an agreement with the Examiner so as to place the application in condition for allowance. The proposed claim amendments more clearly illustrate the present invention and distinguish it from the teachings of Hansen and Mooney.

Accordingly, in the present Amendment, the Applicant has amended Claims 1, 4-6, 8, 10, 11, 13, 15, 17, and 18; added new Claims 22-40; and cancelled Claim 21 without prejudice. The Applicant amended Claims 1, 4-6, 8, 10, 13, 15, 17, and 18 so as to read more clearly, follow proper antecedent format and, where necessary, properly depend from independent Claims 1, 6, and 17.

The Applicant further amended independent Claims 1, 6 and 17 to more clearly define the two-segmented outfeed section of the present invention, each segment being pivotally coupled to the other, each segment further being allowed to pivot in a substantially horizontal plane relative to the other between a storage position and a substantially horizontally planar coaxially connected unloading position. The Applicant additionally amended Claim 17 to detail

that the pivotal coupling between the two segments (the first and second segments) defines only a single axis of pivotal movement, the first segment and the second segment transitioning between a storage position and a substantially horizontally planar coaxially connected unloading position about only one axis of pivot.

As background, the present invention as now claimed in independent Claims 1, 6, and 17 teaches an agricultural combine having a horizontally disposed two-segmented outfeed section, wherein the outfeed section is able to self-sufficiently minimize its length. The first segment of the outfeed section includes a first end and a second end, the first end being coupled to an infeed section of the combine, the second end being hingedly coupled to the second segment. Accordingly, the first segment and the second segment are pivotal relative to one another at the hinged coupling, the pivot being in a substantially horizontal plane, the pivot allowing transition of the first segment and second segment between a storage position and a substantially horizontally planar coaxially connected unloading position.

In contrast, both Hansen and Mooney teach away from the present invention. For example, Hansen teaches a self-unloading wagon having a boom auger to discharge bulk material laterally from a wagon at its forward end. (See Column 1, Lines 9-11.) More specifically, Hansen includes a boom auger, which is rotatable around a vertical axis so as to be able to discharge bulk material laterally out of the wagon. (See Column 4, Lines 71-73.) However, as noted by the Examiner, Hansen fails disclose a two-segmented unloading auger comprising a first segment and a second segment. Without the teaching of a two-segmented unloading auger, Hansen cannot contemplate or teach an unloading auger that can self-sufficiently minimize its length, as taught by the present invention. Thus, Hansen teaches away

from a two-segmented unloading auger, wherein at least one of the first and second segments are pivotal relative to the other, the pivot being in a substantially horizontal plane. Accordingly, it is submitted that Hansen teaches away from the present invention as recited by Claims 1, 2, 4-6, 8, 10, 11, 13, and 15-18.

Mooney also teaches away from the present invention. Mooney discloses a conveyor (i.e. unloading auger) for transporting grain or the like, the unloading auger consisting of three or more segments foldable about two axes of rotation displaced from each other, (see Abstract), the folding occurring on intersecting planes. Thus, for example, a proximal and middle conveyor section might fold in a vertical plane (i.e. about a horizontal axis) and the distal section fold in a generally horizontal plane (i.e. about a vertical axis). (See Figs. 1-3; Column 1, Lines 60-67.) As illustrated by Fig. 2, during the folding process, the proximal auger section 12 remains stationary, while the middle section 14 is pivoted about a generally horizontal axis (i.e. the section travels within a generally vertical plane) and the distal section 16 is pivoted about an axis generally transverse to the axis of rotation of the middle section. The transverse axes of folding permit the middle and distal sections to pivot within intersecting planes, permitting them to lie generally side by side on the upper surface of the grain vacuum apparatus, as seen in FIG. 3. This arrangement permits a more compact folding of the conveyor for storage, and is particularly useful where the conveyor extends from a large piece of equipment such as a grain vacuum device. (See Figs. 1-3; Column 3, Lines 44-57.)

In contrast to the above teachings of Mooney, the present invention teaches an outfeed section having only two segments. Applicant notes that this is a major distinction between the two inventions. Applicant further wishes to note that, although the Examiner indicates that

Mooney discloses that it is known in the art to provide an outfeed section having any number of segments (see Final Rejection, top of Page 3, reference to Column 1, Lines 48-59), Mooney specifically teaches use of at least three outfeed segments. More specifically, Mooney recites within its Specification that: “[t]he auger comprises three or more sections that may be folded in on themselves”, (see Abstract), “[i]t is desirable to provide an auger-type conveyor that is foldable in three or more sections”, (see Column 1, Lines 48-48), “[i]t is an object of the present invention to provide a conveyor and conveyor housing foldable in three or more parts”, etc. (See Column 2, Lines 11-12.) It is thus clear that Mooney specifically teaches away from an unloader auger having only two segments; instead Mooney teaches an unloading auger having at least three, and possibly more, segments. Further, nowhere in its Specification does Mooney contemplate use of less than three unloading auger outfeed segments. Accordingly, Mooney clearly teaches away from an unloading auger having only two segments, as taught by the present invention.

Mooney further teaches away from the present invention because it only contemplates a segmented unloading auger that is foldable in at least two axes, wherein the folding occurs in intersecting planes. (See Fig. 2) Thus, for example, it can be seen that the proximal auger section 12 remains stationary, while the middle section 14 is pivoted about a generally horizontal axis (i.e. the section travels within a generally vertical plane) and the distal section 16 is pivoted about an axis generally transverse to the axis of rotation of the middle section. (See Column 3, Lines 44-57.)

In contrast, the present invention teaches only a two-segmented unloading auger, a hinge being disposed between each segment of the auger to allow each segment to pivot or fold relative

to one the other about only one axis (i.e. about vertical axis A). (See Specification, Page 7, Lines 19-21.) Because the present invention only uses a two-segmented auger, it necessarily follows that each segment of the auger can only pivot relative to the other about one axis. Thus, Mooney's unloading auger, which includes at least three outfeed segments, and which is foldable in at least two axes about intersecting planes, clearly teaches away from the two-segmented, single axis pivot outfeed auger of the present invention.

Mooney would continue to teach away from the present invention regardless of whether, like the present invention, it contemplated an unloading auger consisting of only two outfeed segments. For example, in reference to Figs. 2 and 3 and Column 3, Lines 44-57 of Mooney, it can be seen that if only the proximal auger section 12 and middle section 14 were present (i.e. two segments), the middle auger section 14 would still pivot within a generally vertical plane (i.e. about a generally horizontal axis). Such an embodiment would still teach away from the substantially horizontal plane (i.e. the vertical axis) in which the two segments of the present invention pivot relative to one another. Therefore, and in accordance with the preceding Remarks, it is thus submitted that Mooney, like Hansen, also teaches away from the present invention recited by Claims 1, 2, 4-6, 8, 10, 11, 13, and 15-18.

Where the references cited in a Section 103(a) rejection each teach away from the present invention, there can be no motivation, teaching, or suggestion within the references for one of ordinary skill in the art to look to the references to teach what is recited by the present invention; there can also be no motivation, teaching, or suggestion for one of ordinary skill in the art to look to Mooney to modify Hansen in an attempt to teach the present invention. In fact, teaching away from the present invention is the antithesis of the art's suggestion that one of ordinary skill in the

art move in the claimed direction. Essentially, teaching away from the art is a *per se* demonstration of lack of a *prima facie* obviousness. The mere fact that references can be combined or modified does not render the resultant combination obvious; the prior art must suggest the desirability of the combination. Thus, the test is whether the combined teachings of the prior art, taken as a whole, suggest the modifications to one of ordinary skill in the art.

In light of the above teachings of Hansen and Mooney, it is clear that one of ordinary skill in the art would find no teaching, suggestion, or motivation for their combination to teach what is disclosed by the present invention. For example, one of ordinary skill in the combine harvester art, who knows that it extremely desirable to place outfeed sections of combines in contoured positions along the natural “lines” (i.e. natural contour) of a combine, would not look toward a transportable grain auger apparatus, which is not even adapted or engineered for use with a combine harvester, but instead for use upon the back of a truck or underneath a gravity bed vehicle. Accordingly, there can be no teaching within Hansen and Mooney for their combination.

It is thus submitted that the Hansen and Mooney references do not supply the basis for the combination, but rather the Examiner has made such combination on the basis of hindsight construction. It is improper for a Section 103(a) rejection to be based on the Applicant’s novel solution as a blueprint, with one reference as the main structural diagram, and the other reference for the elements present in the claims but missing from the primary reference. *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998) (“Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.”).

The Federal Circuit has rejected Section 103(a) rejections based on hindsight-based obviousness soundly and repeatedly. “Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references.” *Ecolochem, Inc. v. Southern California Edison Company*, 227 F.3d 1361, 1371, 56 USPQ2d 1065, 1073 (Fed. Cir. 2000); *see also In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.”).

Accordingly, a valid reason to make the combination must exist. “When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.” *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (citing *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)). Thus, the Examiner's statements of obviousness to one of ordinary skill in the art do not suggest a motivation for combination of the two references--rather the statements merely state the objective of the present invention.

Therefore, it is submitted that Hansen and Mooney are inappropriate Section 103(a) references and should be removed. Accordingly, independent Claims 1, 6, and 17 are believed to be patentable and nonobvious over Hansen in view of Mooney. Additionally, Claims 2; 4, 5, 8, 10, 11, 13, 15, and 16; and 18, which depend therefrom, respectively, are also believed to be patentable along with independent Claims 1, 6, and 17.

New Claims 22-40:

The Applicant has added new Claims 22-40. New Claims 22 and 23 depend from independent Claim 1; new Claims 24-27 depend from independent Claim 6; and new Claims 28-34 depend from independent Claim 17. As such, new Claims 22-34 do not add new matter. Accordingly, new Claims 22-34 are believed to be patentable along with independent Claims 1, 6, and 17.

Finally, new Claims 35-40 are directed to a method of moving an auger of an agricultural combine between an unloading position and a storage position in accordance with the structure set forth in Claims 1, 2, 4-6, 8, 10, 11, 13, 15-18, and 22-34. As such, no new matter has been added. Accordingly, in light of the preceding Remarks in reference to independent Claims 1, 6, and 17, it is believed that new Claims 34-40 are also allowable.

In summary, and in light of the Applicant's Remarks and claim amendments, it is believed that Claims 1, 2, 4-6, 8, 10, 11, 13, 15-18, and 22-40 are patentable and in condition for allowance. Therefore, favorable reconsideration of the application is respectfully requested. Should the Examiner believe that the prosecution of the application could be so expedited, he is requested to call Applicant's undersigned Attorney at the number listed below.

Respectfully submitted:

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